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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,349	12/14/2000	Elizabeth Adleberg Brodsky	AUS920000510US1	8921
47959 7590 05/08/2009 IBM AUSTIN (ANTHONY ENGLAND) C/O LAW OFFICE OF ANTHONY ENGLAND PO BOX 5307 AUSTIN, TX 78763-5307				
EXAMINER				
BARQADLE, YASIN M				
ART UNIT		PAPER NUMBER		
2456				
MAIL DATE		DELIVERY MODE		
05/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELIZABETH ADLEBERG BRODSKY,
ELMOOTAZBELLAH NABIL ELNOZAHY,
and RAMAKRISHNAN RAJAMONY

Application No. 09/736,349
Technology Center 2400

Mailed: May 8, 2009

Before CAROLYN L. JOHNSON, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on September 29, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellant filed an Appeal Brief dated December 17, 2007. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c) effective September 13, 2004.

According to 37 C.F.R. § 41.37(c) (v), an Appeal Brief must include the following:

(v) ***Summary Of Claimed Subject Matter.*** A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. < While reference to page and line number of the specification **>requires< somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. >For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 4-8 of the Appeal Brief filed December 17, 2007 is deficient because it does not separately map independent claims 7, 15 and 23 to the specification. In addition, dependent claims 5, 6, 19, 21 and 22, which contain step plus functions, must also be separately mapped to the specification. Correction is required.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed March 21, 2008 under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 and 1207.03 (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds a new Ground(s) of Rejection that has not been provided the required heading "New Grounds of Rejection" and/or which does not include the approval of the TC Director or his/her designee.

Specifically, the Examiner's Answer sets forth the following rejection of claims:

(a) claims 1, 4, 9, 10, 12, 17, 18 and 20 are rejected under 35 U.S.C. § 103(a), whereas the last Office action mailed on September 7, 2006, including any mailed Advisory Action(s), does not include claims 4, 12 and 20 in this ground of rejection because they were objected to by the Examiner;

(b) claims 7, 15 and 23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Najork in view of Kredo and further in view of Challenger, whereas the last Office action, including any mailed Advisory Action(s), indicates these claims as being allowed.

Correction of all Grounds of rejection for all claims is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- (1) hold the Appeal Brief filed on December 17, 2007 defective;
- (2) vacate the Examiner's Answer mailed March 21, 2008;
- (3) generate a new Examiner's Answer setting forth the correct Grounds of rejection and to correct other sections of the Answer as may be required;
- (4) include the approval of the TC Director or his/her designee (as required for any new grounds of rejection); and
- (5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

CLJ

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